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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-------------------------|------------------|
| 09/939,151 | 08/24/2001 | Sylvette Maisonnier | ESSR: 052US | 3004 |
| 7590 | 01/07/2004 | | EXAMINER | |
| Mark B. Wilson Fulbright & Jaworski L.L.P. Suite 2400 600 Congress Avenue Austin, TX 78701 | | | TUCKER, PHILIP C | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1712 | |
| | | | DATE MAILED: 01/07/2004 | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|--|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/939,151 | MAISONNIER ET AL.  |
| | Examiner | Art Unit |
| | Philip C Tucker | 1712 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 October 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 24-66 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 24-27,36,39,42-57 and 62 is/are rejected.
- 7) Claim(s) 28-35,37,38,40,41,58-61 and 63-66 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some *
 - c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) Interview Summary (PTO-413) Paper No(s) _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 42-54 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-25471.

JP '471 teaches a photochromic latex which comprises naphthopyran compounds which is formed using an initiator, such as a persulfate, and monomers such as methacrylates, and wherein a biphasic layer is formed. Such is used to form substrates, such as a lens, which comprises a protective coating over the latex film (see the English translation of the JP document). Such would inherently have the same latex particle size as in the present invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 42-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 10-25471 in view of the Declaration by Maisonnier under 37 CFR 1.132 in serial no. 09/991773 and Postle (4578305).

JP '471 teaches a photochromic latex which comprises naphthopyran compounds which is formed using an initiator, such as a persulfate, and monomers such as methacrylates, and wherein a biphasic layer is formed (see the English translation of the JP document). JP '471 differs from the present invention in that the size of the latex particles are not specifically disclosed. With respect to the declaration of Maisonnier, the teachings therein state that the typical latex formed by different methods of emulsion, still have a particle size of 150-250 nm. The utility of a latex with such size would thus be obvious to one of ordinary skill in the art. Furthermore, it would be obvious to one of ordinary skill in the art to vary the size of the latex particles in order to optimize the photochromic properties of the latex (In re Aller 103 USPQ 233, In re Rose 103 USPQ 237). Postle teaches that variation of the particle size of the latex in a photochromic latex will have a significant impact upon films formed thereby (see columns 5 and 6). The variation of the particle size of JP '471 in order to

obtain improved properties of the photochromic latex, would thus be obvious to one of ordinary skill in the art.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 24-27, 36, 39, 55-57 and 62 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/991773. Although the conflicting claims are not

identical, they are not patentably distinct from each other because although 09/991773 differs by using the term primer instead of initiator, the method of the claims of 09/991773 uses the same components as in the present invention, and would be obvious to one of ordinary skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 28-35, 37, 38, 40, 41, 58-61 and 63-66 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's arguments have been considered but are not deemed fully persuasive. Applicant's arguments with respect to the method claims are deemed persuasive, since the JP reference does teach the addition of the latex after it has already been polymerized. Applicant's other arguments with respect to product claims 42-54 are not deemed persuasive. Applicant has requested that there be provided evidence of the latex within the range of 50 and 400nm, or evidence that a change in latex size would affect the photochromic latex properties. Applicants own declaration provides evidence for the latex having a particle size within the specified range, and Poslte provides evidence that a change in particle size does affect the properties of the photochromic latex. Since applicants declaration has provided evidence that whichever

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method is used to form a typical latex, the particle size is within the scope of the present claims, a rejection under 35 USC 102 has been added fro claims 42-54.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Philip C Tucker
Primary Examiner
Art Unit 1712

PCT-2926